

Fee 122

#19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nelson, Carl T.

Serial No.: 07/683,549

Examiner: K. Peckman

Date Filed: April 10, 1991

Art Unit: 2102

Invention: SWITCHING VOLTAGE REGULATOR CIRCUIT

RECEIVED

MAY 24 1994

GROUP 2100

CERTIFICATE OF SERVICE

I hereby certify that this correspondence has been served on Counsel for Applicant by first class mail postage prepaid in an envelope addressed to: Mark D. Rowland, FISH & NEAVE, 1251 Avenue of the Americas, New York, New York 10020 on May 24, 1994.

By: Eliza A. Brown

Honorable Commissioner of
Patents and Trademarks
Washington, DC 20231
ATTENTION: Director Group 210

PETITION UNDER 37 CFR 1.182 FOR PERMISSION TO FILE PROTEST

Dear Sir:

Petitioner submits that as required by 37 CFR 1.291(a)(1), the Protest accompanying this Petition is timely. The MPEP at §1901.04 recommends that a protest to a reissue application be filed within the two month period following announcement of the filing of the reissue application in the Official Gazette. This Protest is being filed within one month of Petitioner's office learning that the present reissue application was not abandoned. Moreover, new claims were recently filed in the reissue application raising new issues that could only now be addressed

by the Protest filed herewith. Serious questions of patentability have been raised by the Protest.

Petitioner's office first obtained a copy of the above-identified reissue application prosecution history on December 10, 1993. At that time, the application had been rejected in its entirety and Applicant had not responded to the rejection. Therefore, the application was headed towards abandonment. Petitioner's office checked the file again on March 1, 1994. As of that date, the Examiner handling the application had not received a response to the outstanding office action. The six month period for abandonment of the application expired on March 7, 1994. It was not until March 21, 1994 that a response was received by the Group 2100.

Petitioner's staff was not able to obtain a copy of the response until April 29, 1994. The response adds new claims to the application that raise significant new issues. The Protest is required in order to bring to the Examiner's attention prior art that invalidates the new claims and issues of patent law that should be considered before passing upon the present reissue application. The Protest is being filed herewith, less than one month after Petitioner's office learned of the contents of the response. The response derailed the expected abandonment and added new claims.

Petitioner submits that the speed with which this Protest was prepared and filed after learning that the reissue application was not abandoned demonstrates that this filing is

timely as required by the rule. Moreover, the response raised issues for the first time that are timely addressed by the Protest. If necessary, the timeliness requirement should be waived in view of the prompt preparation of the Protest after receipt of the response and the seriousness of the unpatentability issues raised by the prior art enclosed in the Protest and the applicability of the patent laws to the reissue claims. It is important that the Examiner have the opportunity to review the matters set forth in the Protest in order to better insure that the patent application complies with the laws of the United States. It is Petitioner's understanding that the application is presently awaiting action by the Examiner.

The petition fee provided by 37 CFR 1.17(h) of \$130.00 is enclosed herewith.

Respectfully submitted,



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